REMARKS

This responds to the Final Office Action mailed on July 10, 2008.

Claims 1, 6, 10, 17, 26 and 31 are amended, no claims are canceled or added; as a result, claims 1-34 remain pending in this application. Support for the amendments may be found throughout the specification, and in particular on pages 7-10 of the specification and in Appendix A of the specification. Applicant respectfully submits that no new matter has been introduced with the amendments.

Interview Summary

Applicant thanks Examiner Jeffrey Wong for the courtesy of a personal interview on October 22, 2008 with Applicant's representative Rodney Lacy. The attributes of a game rules script were discussed during the interview. No agreement was reached regarding the claims.

§102 Rejection of the Claims

Claims 1-3, 6-7, 9-19, 22-23, 25-28, 31, 32 and 34 were rejected under 35 U.S.C. § 102(b) for anticipation by Bob Dancer's WinPoker (hereinafter "WinPoker"). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *M.P.E.P § 2131*. To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter. *PPG Industries, Inc. V. Guardian Industries Corp.*, 75 F.3d 1558, 37 USPQ2d 1618 (Fed. Cir. 1996). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Applicant respectfully submits that claims 1-3, 6-7, 9-19, 22-23, 25-28, 31 and 34 contain elements not found in WinPoker.

For example, claims 1 and 26 recite "receiving during the runtime of a wagering game a game rules script, the game rules script comprising text specifying a set of game elements for a wagering game, the text further defining one or more rules to determine a set of one or more winning outcomes in terms of one or more of the set of game elements." The Office Action states that "the script is viewed as the set of rules a player can choose from in terms of methods of play." Further, in the "Response to Arguments", the Office Action states that "Game scripts are viewed as game parameters that can be used to control game behavior." Applicant disagrees that WinPoker teaches a game rules script. A script is more than just a specification of parameters (i.e., data values). As recited in the claims, a game rules script comprises text that defines a set one or more rules to define a set of one or more winning outcomes in terms of a set of game elements. Game rules go far beyond game parameters. Fig. 4 merely shows that a player may choose a pay table for a set of winning outcomes that appear to have already been defined in the code. The text in Figure 4 merely specifies the name of a game. There is no disclosure in WinPoker of any text that <u>defines</u> game elements and winning outcomes in terms of the game elements. The program does not appear to read a game rules script in order to determine how the game elements define various winning outcomes. Rather the game elements defining a winning outcome appear to be predetermined in the WinPoker code, and a user may use the mechanism described in Fig. 4 to select a pay table defining pay amounts for the various predefined winning outcomes.

As an example of the difference, a user may produce a game rules scripts defining a winning outcome in which a hand consisting of all even numbered cards is a winning outcome. The user of WinPoker has no such ability. Rather, in WinPoker, a user is limited to selecting winning outcomes from those that have already been provided for in the executable WinPoker program. Alternatively, a user may produce a game rules script in which the number 2 face and the number 5 face of a set of dice are "wild" and match any other face of a set of dice. Again, WinPoker does not disclose any interface for a user to specify wild game elements or rules for using wild game elements in a game.

Additionally, claims 1 and 26 recite parsing a game rules script. Parsing involves reading text and dividing the text into components that may be used by a method. The Office Action correctly states that "a data structure can be implemented for the other methods of game play as

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well." However, the claim recites parsing a game rules script, which is much more than merely providing a data structure. As recited in the claims, the game rules script is parsed into a game rules data structure. Nothing in the Figures provided by the Office Action show any parsing activity.

     In view of the above, WinPoker does not disclose receiving a game rules script or parsing a game rules script, and therefore does not disclose each and every element of claims 1 and 26. As a result, WinPoker does not anticipate claims 1 or 26. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1 and 26.

     Claims 2-3, 6-7, and 9 depend from claim 1 and claims 27-28, 31, 32 and 34 depend from claim 26. These dependent claims inherit the elements of their respective base claims and are therefore allowable for at least the same reasons as discussed above regarding their respective base claims. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 2-3, 6-7, 9, 27-28, 31, 32 and 34.

     Additionally, claims 9, 25 and 34 recite elements of a specific method for determining if a match exists according to match rules. With respect to claims 9, 25 and 34, the Office Action merely refers to Figure 4 and states "in order for a player to achieve a certain hand, the game elements needs to be compared in order to achieve a winning outcome." Nothing in Figure 4 or in WinPoker as a whole discloses any algorithm or method for evaluating matches for a set of game elements and match rules. Figure 4 does not disclose a method of any kind, rather Figure 4 is a display of a selection screen for choosing a game. Additionally, there is no disclosure in Figure 4 or in WinPoker of any formation of a reduced matched set. Because none of the operations of the method recited in claims 9, 25 and 34 are disclosed in Figure 4 and because WinPoker does not disclose forming a reduced match set, WinPoker does not anticipate claims 9, 25 or 34.

     Claim 10 as amended recites a game rules script on a computer-readable medium where the game rules script includes text defining a set of game elements and text defining a set of winning outcomes. WinPoker does not disclose any text that is used to define the game elements that are part of a wagering game. The Office Action asserts that Figure 3 discloses "text defining a set of winning outcomes for a game", stating "The numbers are viewed as text". While it may be true that the numbers are text, the numbers in Figure 3 do not define a winning outcome.

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Rather, the numbers in Figure 3 are the output of predetermined winning combinations, they are not themselves used to define the winning combination. The Office Action further relies on Fig. 4 and asserts that Fig. 4 discloses a set of rules for each winning outcome. As discussed above, Fig. 4 merely discloses a way to select differing pay tables for predefined winning combinations, nothing in Fig. 4 nor any other portions of WinPoker discloses the ability to use a game rules script to define game elements that make up a winning outcome. As a result, WinPoker fails to disclose each and every element of claim 10. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claim 10.

Claims 11-16 depend from 10 and therefore inherit the elements of claim 10 in addition to providing further patentable distinctions. Claims 11-16 are therefore allowable for at least the same reasons as discussed above regarding base claim 10.

Claim 17 as amended is a system claim that recites a system that includes a game rules script and a parser that parses the game rules script. The game rules script comprises "text defining a set of game elements for a wagering game, the text further including a set of winning outcomes for a game, each of the set of winning outcomes including a set of match rules expressed in terms of the set of game elements." As discussed above with respect to claims 1 and 26, WinPoker does not disclose a game rules script comprising text that defines rules in terms of game elements defined in the text, and does not disclose parsing a game rules script. As a result, WinPoker does not disclose each and every element of claim 17. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claim 17.

Claims 18-19, 22-23 and 25 depend from claim 17 and therefore inherit the elements of claim 17 in addition to providing further patentable distinctions. Claims 18-19, 22-23 and 25 are therefore allowable for at least the same reasons as discussed above regarding base claim 17.

§103 Rejection of the Claims

Claims 4-5, 8, 20-21, 24, 29, 30 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WinPoker and further in view of Mikohn Gaming Introduces Yahtzee Slot Machine (hereinafter "Mikon"). The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman*

Coulter, Inc., 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is

obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v.*

John Deere Co. of Kansas City, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The

underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the

prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary

skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

　　　The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of

obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To

establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught

or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ;

M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that

claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA

1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the

Examiner's analysis must show that some objective teaching in the prior art or that knowledge

generally available to one of ordinary skill in the art would lead an individual to combine the

relevant teaching of the references. *Id.* To facilitate review, this analysis should be made

explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385

(2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

　　　Each of claims 4-5, 8, 20-21, 24, 29-30 and 33 depends from a claim that recites a game

rules script where the game rules script comprises "text defining a set of game elements for a

wagering game, the text further including a set of winning outcomes for a game, each of the set

of winning outcomes including a set of match rules expressed in terms of the set of game

elements." As discussed above, WinPoker does not teach or suggest a games rules script where

the script defines the game elements and rules for a wagering game using the game elements, nor

does WinPoker teach or suggest parsing a game rules script. Applicant has reviewed Mikohn

and can find no teaching or suggestion of a game rules script or parsing a game rules script. As a

result, the combination of WinPoker and Mikohn fails to teach or suggest each and every

element of Applicant's claims 4-5, 8, 20-21, 24, 29-30 and 33. Therefore there are differences

between the cited references and the claims at issue. As a result, claims 4-5, 8, 20-21, 24, 29-30

and 33 are not obvious in view of the combination of WinPoker and Mikohn. Applicant

respectfully requests reconsideration and the withdrawal of the rejection of claims 4-5, 8, 20-21, 24, 29-30 and 33.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at (612) 373-6954 to facilitate prosecution of this application.
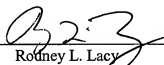
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Respectfully submitted,

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Date ___December 10, 2008___ By _____
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Name _____   Signature _____